

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: David Yu Chang	§	Group Art Unit:	2165
	§		
Serial No.: 10/732,756	§	Examiner:	Mizrahi, Diane D.
	§		
Date Filed: December 10, 2003	§	Confirmation No.:	6545
	§		
Title: Functional and Stress Testing of LGA Devices	§	IBM Docket No.:	AUS920030884US1
	§	Atty. Docket No.:	(4023)

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION MAILED JUNE 28, 2006

First, Applicant notes that it appreciates the telephone conversation that Examiner Mizrahi had with Applicant's attorney on August 8, 2006.

Specification – Typos in Claims 16-20

Now, turning to the merits of the office action, Applicant first responds to the objections made to claims 16-20. Examiner's query in the Office Action is correct. That is, Applicant did not intend to present multiple dependent claims 16-20. Instead, these were typos, and each of these claims should have been presented as being dependent from independent claim 15. Accordingly, Applicant presents amended claims 16-20 herewith in order to correct the typos in original claims 16-20.

Claim Rejections under 35 USC § 101

The Office Action rejects original claims 1-20 as being “directed to non-statutory subject matter” because “the claims are not directed towards the final result that is ‘useful, tangible, and concrete.’” Applicant respectfully objects, with traverse, to these § 101 rejections lodged against original claims 1-20.

Applicant contends that each of original claims 1-20 are drawn to statutory subject matter, i.e., a “new and useful process, machine, manufacture ... or any new and useful improvement thereof.” 35 U.S.C. § 101. Here, Applicant agrees with the Office’s non-contention that Applicant’s invention is neither “new and useful” nor involves a “process, machine, manufacture ... or any new and useful improvement thereof.” *Id.* Further, Applicant agrees with the Office’s concession that “[a] claim limited to a machine or manufacture, which has a practical application, is statutory.” Office Action, p. 2. This is the case with each of Applicant’s original claims. That is, Applicant’s original claims are directed towards numerous functions controlled by an mbean server application used to manage resources, i.e., a tangible item managing another tangible item. Thus, original claims 1-20 have a practical application because they are directed towards a specific machine/tangible item and “manage” “resources” as defined in the specification; thus, claims 1-20 are statutory. However, according to the Office’s referenced New Guidelines of October 26, 2005, Applicant’s claims must be further evaluated to determine if they are “directed towards the final result that is ‘useful, tangible, and concrete.’” *Id.*

Applicant contends that each of original claims 1-20 do produce “useful, tangible and concrete results.” Specifically, each of the independent claims 1, 8, and 15 include processes or apparatuses that involve, for instance, the sending and receiving of electrical signals and voltage

changes as known to one of ordinary skill in the art, in order for an mbean server application to manage a particular resource as defined in the specification. The management of a resource is useful, and the Office does not controvert that fact. The last-listed claim element in each independent claim is to determine whether the user has an authority to perform the request sought to be performed on a particular resource. Determining authority, in itself, is a tangible and concrete result. That is, the determination by the mbean server application may be either to grant or not grant the user authority for the request, which is an action, that the user seeks to do using a particular resource. As a result, Applicant has shown that original claims 1-20 do produce “useful, tangible and concrete results,” and, thus, are statutory allowable patent claims. To even further clarify the “tangible and concrete results,” however, Applicant presents amendments herewith for original claims 1-20.

Finally, Applicant presents amendments herewith for original claims 15-20 that substitute the Office’s suggested “computer-readable storage medium” in place of Applicant’s “machine-accessible medium,” wherein the former is synonymous with or at least an example of the latter.